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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,525	07/23/2003	Shunichiro Nonaka	0649-0903P	6670
2292 7590 05/17/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER MILIA, MARK R	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 05/17/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

Application No.

10/624,525

Applicant(s)

NONAKA, SHUNICHIRO

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 7-9 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium.

Claims 7-9, while defining an image-attached mail transiting program, does not define a "computer-readable medium" and is thus non-statutory for that reasons. An image-attached mail transiting program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to have a "computer-readable medium" encoded with the program in order to make the claim statutory.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent Application Publication No. 2003/0208546 to DeSalvo et al.

Regarding claim 1, DeSalvo discloses an image-attached mail transiting apparatus for performing predetermined image processing for an image according to a type of a transmitting terminal with a camera, which transmits an E-mail to which the image is attached, comprising: type discriminating means for discriminating the type of the transmitting terminal, which transmits the E-mail to be received by the image-attached mail transiting apparatus (see Figs. 1 and 2 and paragraph 19), parameter deciding means for deciding a first parameter indicating what processing should be performed for an attached image of the E-mail according to the type of the transmitting terminal (see Figs. 1 and 2 and paragraphs 17, 19, 24, 28, 30, and 34, reference states that attachment processing module **240** processes e-mail attachments transmitted to and from the wireless device **110**, which shows wireless device **110** can be a transmitting device or a receiving device), and image processing means for performing predetermined image processing based on the first parameter for the attached image (see Figs. 1 and 2 and paragraphs 17, 19, 24, 28, 30, and 34), wherein an image processed by the image processing means is substituted for the attached image of the E-mail, and then an altered E-mail, to which a substituted image is attached, is transmitted to a receiving terminal (see paragraphs 24, 26, 28, 30, 32, and 34).

Regarding claims 4 and 7, DeSalvo discloses an image-attached mail transiting method and program for performing predetermined image processing for an image according to a type of a transmitting terminal with a camera, which transmits an E-mail to which the image is attached, comprising: a first type discriminating step of discriminating the type of the transmitting terminal, which transmits the E-mail (see Figs. 1 and 2 and paragraph 19), a first parameter deciding step of deciding a first parameter indicating what processing should be performed for an attached image of the E-mail according to the type of the transmitting terminal (see Figs. 1 and 2 and paragraphs 17, 19, 24, 28, 30, and 34, reference states that attachment processing module **240** processes e-mail attachments transmitted *to* and *from* the wireless device **110**, which shows wireless device **110** can be a transmitting device or a receiving device), a first image processing step of performing predetermined image processing based on the first parameter for the attached image; an image substituting step of substituting an image processed in the first image processing step for the attached image of the E-mail (see paragraphs 24, 26, 28, 30, 32, and 34), and a mail transmitting step of transmitting an altered E-mail, to which a substituted image is attached, to the receiving terminal (see paragraphs 24, 26, 28, 30, 32, and 34).

Regarding claim 2, DeSalvo further discloses wherein the type discriminating means discriminates the type of the receiving terminal having a display (see Fig. 2 and paragraphs 19 and 24), the parameter deciding means decides a second parameter indicating what processing should be performed for the attached image of the E-mail

according to the type of the receiving terminal (see paragraphs 17, 19, 24, 28, and 30), and the image processing means performs predetermined image processing based on the second parameter for the attached image (see paragraphs 17, 19, 24, 28, and 30).

Regarding claims 3, 6, and 9, DeSalvo further discloses wherein the type discriminating means discriminates the type of the receiving terminal having a display (see Fig. 2 and paragraphs 19 and 24), the parameter deciding means decides a parameter indicating what processing should be performed for the attached image of the E-mail according to the type of the transmitting terminal and the type of the receiving terminal (see paragraphs 17, 19, 24, 28, and 30), and the image processing means performs predetermined image processing based on the parameter for the attached image (see paragraphs 17, 19, 24, 28, and 30).

Regarding claims 5 and 8, DeSalvo further discloses a second type discriminating step of discriminating the type of the receiving terminal having a display (see Fig. 2 and paragraphs 19 and 24), a second parameter deciding step of deciding a second parameter indicating what processing should be performed for the attached image of the E-mail according to the type of the receiving terminal (see paragraphs 17, 19, 24, 28, and 30), and a second image processing step of performing predetermined image processing based on the second parameter for the attached image (see paragraphs 17, 19, 24, 28, and 30), wherein the image substituting step substitutes an image processed in the first image processing step and the second image processing step for the attached image of the E-mail (see paragraphs 24, 26, 28, 30, 32, and 34).

**Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art please refer to the attached Notice of References Cited.

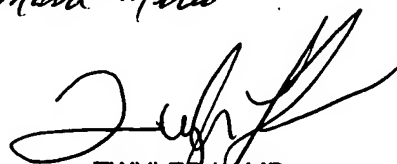
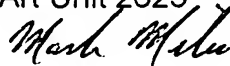
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRM

Mark R. Milia  
Examiner  
Art Unit 2625



TWYLER LAMB  
SUPERVISORY PATENT EXAMINER